Application No: 09/681,008
Filed: November 15, 2000
Group: 2881

b.) REMARKS

Turning first to the Office Action Summary Sheet, claims 1, 2, 4-6, 8-22 are pending in this application. Claim 1 has been amended as indicated hereinabove.

Claims 1, 2, 4-6, 8-22 were rejected under 35 USC 103(a) over US Patent 5,881,045 to Inoue ("Inoue") in view of US Patent 6,275,454 to Boutaghou ("Boutaghou"). Applicant respectfully disagrees and presents the following arguments in support of patentability.

With regard to the patents of Inoue and Boutaghou cited by the Patent Office, Applicant respectfully points out to the Patent Office that the citation would have been proper only if considered by a person of average skill in the art at the time the invention was made. It has been well established that a person skilled in the art is not a layperson, nor one skilled in remote arts[1].... A person skilled in the art is presumed to be one who thinks along the lines of conventional wisdom in the art and not the one who undertakes to innovate, whether by extraordinary insights or by patient and often expensive systematic research[2].

The Inoue and Boutaghou patents cited by the Patent Office in its obviousness rejection are in the art of a CD player with a stabilizing disk driver mechanism (Inoue) and in the art of high density disk drives employing lenses that aerodynamically control head/disk spacing. None of these patents is remotely related to the art of scanning microscopy and analysis of multiple specimens by optically scanning the multiple specimens and measuring and comparing the relevant parameters of the multiple specimens, as described in paragraphs 7 and 8 of the present specification. To more particularly point out the relevant art of the invention, Claim 1 was amended to more particularly point out the relevant field of the invention.

[1] Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693 (Fed. Cir. 1983).
[2] Standard Oil v. American Cyanamid Co. 774 F.2d 861 (Fed. Cir. 1985).

With regard to 35 USC 103(a), it is known that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations[3].

Specifically, Inoue shows a disk player with a disc drive mechanism. The optical head is mounted in a fixed position and the turntable is moved to advance the rotating disk over the optical head (see Col. 3, lines 13-15). Contrary to the invention claimed in amended claim 1 Inoue does not disclose a specimen receiving device for holding a plurality of specimens and a scanning device being linearly and rotatable displaceable. The combination of Inoue with Boutaghou does not provide each and every element of the invention claimed in amended Claim 1, because the Patent Office is not right when alleging that the Boutaghou scanning device is linearly displaceable and rotatable (to the extent that Boutaghou could be considered to be within relevant art, which it is not). Therefore, no teaching or suggestion of such an optical scanning apparatus in a confocal scanning microscope could be found in a combination of Inoue and Boutaghou.

Furthermore, with regard to some suggestion or motivation to modify the references or to combine reference teachings, as well as to a reasonable expectation of success, it has been well articulated that a factual inquiry whether to combine references must be based on objective evidence of record[4] and that teachings of references can be combined only if there is some suggestion or incentive to do so[5]. Applicant's attorney has carefully studied the Inoue and Boutaghou patents and was unable to find any teaching or suggestion to an optical scanning apparatus in a confocal scanning microscope containing each and every element as recited in amended Claim 1. Therefore, Applicant respectfully asserts that the Patent Office has not met its burden of proof of obviousness and that

[3] MPEP 2142-2143
[4] In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).
[5] In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

independent claim 1 as amended is now patentable. Allowance of Claim 1 is respectfully requested.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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